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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,596	12/05/2003	Srikanth Gadamsetty	E0710.0004/P004	7503
24998	7590	07/17/2006	EXAMINER	
DICKSTEIN SHAPIRO LLP			NGUYEN, MERILYN P	
1825 EYE STREET NW			ART UNIT	
Washington, DC 20006-5403			PAPER NUMBER	
			2163	

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,596

Applicant(s)

EDGENET INC.

Examiner

Merilyn P. Nguyen

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/29/04 & 02/02/06</u> . | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

Art Unit: 2163

DETAILED ACTION

1. Claims 1-22 are pending in this action.

Acknowledges

2. Receipt is acknowledged of the following items:

Information Disclosure Statement (IDS) filed on 04/29/2004 and 02/02/2006 and made of record. The references cited on the PTOL 1449 form have been considered.

Specification

3. The disclosure is objected to because of the following informalities:

status of incorporated reference must be updated at page 1, paragraph [0001] of the specification.

The title is too long, the preferable title is between 2-7 words.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 21 06(II)A:

Art Unit: 2163

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96),¹ In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)34. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce

Art Unit: 2163

a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

Claimed invention (Claims 1-7) recites "A database processing system, comprising: a first portion for accessing data from a second portion; a third portion for enabling user interaction with said first portion such that a frame based knowledge tree is automatically constructed with said data in response to said user interaction" which do not provide useful, tangible and concrete results. The frame based knowledge tree is constructed without practical application as to how/what is the knowledge tree being used. Moreover, for it to be a tangible result, it must be more than just a thought or a computation. Instead, it must have real world value rather than being an abstract result.

Claimed invention (Claims 8-16) recites "a method comprising: accessing data from a database; receiving indications from a user regarding said data; and automatically constructing a frame based knowledge tree from said data in response to said act of receiving." which do not provide useful, tangible and concrete results. The frame based knowledge tree is constructed

Art Unit: 2163

without practical application as to how/what is the knowledge tree being used. Moreover, for it to be a tangible result, it must be more than just a thought or a computation. Instead, it must have real world value rather than being an abstract result.

Claimed invention (Claims 17-22) recites “a method of automatically constructing a frame tree, the method comprising: identifying a plurality of attributes within a vendor database to be inducted into a frame based knowledge tree; automatically determining respective locations of said plurality of attributes within said knowledge tree; and inserting at least one of said attributes into said knowledge tree based on said determined respective locations.” which do not provide useful, tangible and concrete results. For it to be a tangible result, it must be more than just a thought or a computation. Instead, it must have real world value rather than being an abstract result. The steps of identifying a plurality of attributes, determining respective locations of said plurality of attributes and inserting at least one of said attributes into said knowledge tree based on said determined respective locations do not provide practical application as to how/what is the knowledge tree being used in real world.

Claim Rejections - 35 USC § 112

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 8-12 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

Art Unit: 2163

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 is directed to “first portion”, “second portion” and “third portion”, however, in the specification, “first portion”, “second portion” and “third portion” are not described or defined.

Claim 8 recites the term “indications” and claims 8-12 and 18-21 recite the term “act”, however, in the specification “indications” and “act” are not described or defined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, the preamble recites “constructing a frame tree”, however, there are no given steps to arrive “constructing a frame tree”. The body of the claim recites “a frame based knowledge tree”, however, there is a distinction between “a frame tree” and “a frame based knowledge tree”.

Due to the vagueness and a lack of clear definition of the terminology and phrases used in the specification and claims, the claims have been treated on their merits as best understood by the examiner.

Art Unit: 2163

The Applicant is responsible for fixing all other 112 problems if it exists in the claims beside those that the Examiner addressed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-13 and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Bankier (US 6,567,814).

Regarding claim 1, Bankier discloses a database processing system (See Figs. 1-5), comprising: a first portion (processing unit 12) for accessing data from; a second portion (data storage 16); a third portion (graphic display 14) for enabling user interaction with said first portion such that a frame based knowledge tree is automatically constructed with said data in response to said user interaction (See col. 11, lines 16-22 and col. 14, lines 42-46).

Regarding claim 2, Bankier discloses wherein said first portion comprises an induction module (See col. 9, line 58 to col. 12, line 51).

Regarding claim 3, Bankier discloses wherein said second portion comprises a vendor database and said data comprises specification data for at least one product (See col. 9, lines 19-24 and col. 15, lines 9-12).

Art Unit: 2163

Regarding claim 4, Bankier discloses wherein said second portion comprises a plurality of tables following a relational schema (See col. 19, lines 1-16).

Regarding claim 5, Bankier discloses wherein said third portion comprises a graphical user interface (graphic display 14, Fig. 1) coupled to said first portion.

Regarding claim 6, Bankier discloses a database access module (sql) coupled between said vendor database and said first portion for enabling access to said vendor database (See col. 8, lines 38-50).

Regarding claim 7, Bankier discloses a product knowledge output module coupled to an output of said induction module for converting said frame based knowledge tree into product knowledge files for use with a configuration system (See col. 14, lines 42-46).

Regarding claim 8, Bankier discloses a data processing method, the method comprising:
accessing data from a database (See col. 15, lines 43-50);
receiving indications (“user-specified criteria”) from a user regarding said data (See col. 15, lines 51-54); and
automatically constructing a frame based knowledge tree from said data in response to said act of receiving (See col. 11, lines 16-22 and col. 14, lines 42-46).

Art Unit: 2163

Regarding claim 9, Bankier discloses accessing a vendor database table containing product data for a product (See col. 9, lines 19-24).

Regarding claim 10, Bankier discloses accessing a plurality of tables following a relational schema (See col. 19, lines 1-16).

Regarding claim 11, Bankier discloses receiving user preferences (“user-specified criteria”) regarding construction of said frame based knowledge tree via a user interface (See col. 15, lines 51-54).

Regarding claim 12, Bankier discloses identifying at least one product attribute in said data (See col. 9, lines 19-24); identifying at least one unique attribute value associated with said at least one product attribute (See col. 10, lines 1-7); and creating a new node of said knowledge tree for each unique attribute value identified (See col. 14, lines 42-46).

Regarding claim 13, Bankier discloses identifying at least one user-specified attribute to be inducted into said knowledge tree (See col. 10, lines 1-34); and querying said data for at least one unique attribute value associated with said user-specified attribute (See col. 10, lines 1-34).

Regarding claim 17, Bankier discloses a method of automatically constructing a frame tree, the method comprising: identifying a plurality of attributes within a vendor database to be inducted into a frame based knowledge tree (See col. 9, line 19 to col. 10, line 34); automatically

Art Unit: 2163

determining respective locations of said plurality of attributes within said knowledge tree (See col. 10, lines 19-26); and inserting at least one of said attributes into said knowledge tree based on said determined respective locations (See col. 10, lines 21-34 and col. 14, lines 42-46).

Regarding claim 18, Bankier discloses wherein said act of automatically determining comprises: identifying user preferences for constructing said knowledge tree (“user-specified criteria”) (See col. 15, lines 51-54); and determining said respective locations based on said user preferences (See col. 10, lines 21-26).

Regarding claim 19, Bankier discloses determining that a user has employed a domain knowledge specification for constructing said knowledge tree. (See col. 18, lines 62-65).

Regarding claim 20, Bankier discloses determining that a user has employed a distinct attribute values count for constructing said knowledge tree (See col. 19, lines 63-67 and col. 20, lines 24-25).

Regarding claim 21, Bankier discloses querying at least one vendor-supplied product knowledge database table for said attributes (See col. 15, lines 13-50).

Regarding claim 22, Bankier discloses converting said frame based knowledge tree into at least one product knowledge file for use with a configuration system (See col. 14, lines 42-46).

Art Unit: 2163

Allowable Subject Matter

8. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 15 and 16 is depend on claim 14 therefore is objected the same.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldman U.S Patent No. 6,952,688 discloses knowledge-engineering protocol-suite.

Zhang US 2002/0103777 discloses computer based knowledge system.

Hazlehurst U.S Patent No. 6,289,353 discloses intelligent query system for automatically indexing in a database and automatically categorizing users.

Carpenter U.S Patent No. 6,260,048 discloses resolution of incidents which occur during the use of a product.

Sebastian U.S Patent No. 5,822,206 discloses concurrent engineering design tool and method.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 571-272-4026.

The examiner can normally be reached on M-F: 8:30 - 5:00.

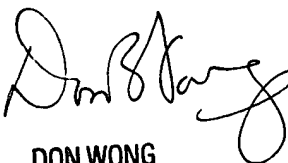
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the

Art Unit: 2163

organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN
MN
July 9, 2006


DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100